



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,870	03/22/2001	Gary Anthony Jubb	M8540/250731	1015

23370 7590 05/29/2003

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER

MARCANTONI, PAUL D

ART UNIT PAPER NUMBER

1755

DATE MAILED: 05/29/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,870

Applicant(s)

Jubb

Examiner

Paul Marcantoni

Group Art Unit

1755

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 3/17/03.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-28 is/are pending in the application.
- Of the above claim(s) 27-28 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 11
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Applicant's election with traverse of Group I, claims 1-26 in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the examiner merely expresses his opinion regarding the Group I invention by showing references that are rejected under 35 USC 102/103. The applicants also infer that left alone that claims 27-28 would be allowable under the assumption that this examiner would allow those claims whilst another would not. The applicants also point out that the low amount of aluminum is the common technical feature of the invention which limits the reactivity of the fibers and composite paper made therefrom at temperatures greater than 1100 C.

This is not found persuasive because the examiner has provided references rejecting claim 1 meeting this claim features which makes it that the Group I composite does not make a contribution over the prior art (because these references teach it), unity of invention is thus lacking, and restriction is appropriate. Applicants have not traversed these references to show why these references teach away from their invention and do make a contribution over the prior art for the Group I composite.

Applicants merely assert the examiner expresses his opinion which is not the case. It would appear that applicants have a problem with this restriction because this was filed under 35 USC 371. Contrary to applicants' own opinions, these cases in certain situations such as the one provided by the examiner are properly restrictable. This is proper under PCT rule 13.1, 13.2, 35 USC 121, 372, and 37 CFR 1.499 as providing the basis for the rejection. The applicants may consider taking this issue before PTO management or call for their own rule change because they provided the training for making 35 USC 371 restrictions in cases such as the one provided for this

application. It is assumed if PTO management provided the training for examiners, they gave approval for the propriety of these rejections and hold they are thus proper.

The next point is that the present examiner would allow claims 27-28 and these would not be allowable by a different examiner. In rebuttal, the applicants' inference is not understood. A proper search in the paper art for their invention may or may not lead to patentable subject matter. A search of course is required before the examiner can express his position on patentability.

Also, the fact that a common technical feature is present in Group I and Group II (composite and paper) of low aluminum does not mean the two groups of inventions must be searched together. Again, the examiner has shown by rejecting claim 1 of Group I that this invention does not provide a contribution over the prior art and has been untraversed by applicants. The examiner has provided reasons why the restriction is proper and applicants offer their own opinion as to why the restriction is improper. The examiner maintains that he has followed the rules of PCT, CFR and USC as well as the training provided by Tech Center 1700 (as well as throughout the Patent Office) regarding proper instances of restriction under 35 USC 371.

It is the examiner's position that if applicants assert that both Group I and Group II have common technical features, it can be assumed that they hold these groups are also obvious variants. After all, both groups are composites yet are all composites necessarily paper? Applicants is invited to state for the record if they hold these groups to be obvious variants yet at this time it is the examiner's position that the holding of

Art Unit: 1755

restriction is proper. The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are rejected under 35 U.S.C. 102(a and b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hart '994, '172, '173, Delvaux et al. '046, Vandermeer '102, Couture et al., Besnard et al., or Jubb et al. (US Patent No. 6,180,546).

All of the above cited references teach a composite containing ceramic fiber (e.g. alkaline earth metal silicate and colloidal silicate) in amounts overlapping the instantly claimed invention. Even if not anticipated, overlapping ranges of amounts would have been prima facie obvious to one of ordinary skill in the art. (see respective claims).

Claims 4-25 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The terms "essentially free" would appear indefinite in claims 4, 8 and wherever present in the claims because it is not clear what they mean by this term. How does essentially free differ from the range of less than 1 wt%? If it is not different, than claims containing these terms would fail to further limit claim 1 because essentially free would mean there is some residual aluminum. Essentially free does not make clear whether this means "less than 1 wt%" or possibly an even smaller range such as lower than less than .01 wt%. Clarification is requested.

The terms "capable of" would appear indefinite in claim 11. Deletion of capable and insertion of —is used—is advised.

The use of parentheses after the term "ingredients" in claim 12 and after Colloidal silica would appear improper and indefinite. Removal of parentheses is advised.

Claim 17 is indefinite because applicants do not provide the total parts by weight of the composite material.

Claim 21 and 22 are vague as written. Is 0.5 to 4% by weight of solids to white water component a ratio or does this represent the amount of alkaline earth metal silicate fiber?

Claim 18 and 19 are vague as it is unclear if the total weight percent must add up to 100% or if the amount of the total compositions actually increase over 100%.

The term "mains water" would appear vague throughout the claims (e.g. claims 21, 22, and 25). What is this?

Art Unit: 1755

White water would appear indefinite throughout the claims until applicants clarify what they mean by mains water.

The terms "low sodium content colloidal silica" is vague and indefinite in claim 25. What is the range of what applicants consider low sodium for this term?

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Paul Marcantoni
Primary Examiner
Art Unit 1755